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Examining Group 1641

Date: 7/27/2006
From: Elizabeth Orr, Invitrogen Corp.
To: Commissioner for Patents
Organization: U.S. Patent and Trademark Office
Fax: (571) 273-8300
Subject: Response to Election of Species Requirement
Serial No.: 10/035,368

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Hoeftler et al.)	Examiner: L. V. Cook
)	
Serial No.: 10/035,368)	Group Art Unit: 1641
)	
Filed: October 26, 2001)	Docket No. IVGN 274.1 DIV
)	
Title: Microarrays and Uses Therefor)	<u>TRANSMITTAL LETTER</u>
)	
)	
)	

Mail Stop Amendment
Commissioner for Patents
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

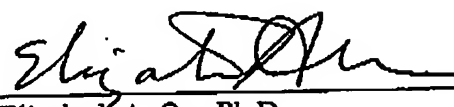
Dear Sir:

Transmitted herewith are the following documents in the above-identified application.

[X] Response to the Office Action mailed June 27, 2006

Respectfully submitted,

Date: July 27, 2006


Elizabeth A. Orr, Ph.D.
Reg. No. 45,937

Invitrogen Corp.
1620 Faraday Ave.
Carlsbad, CA
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CERTIFICATE OF TRANSMISSION	
I HEREBY CERTIFY THAT THIS PAPER AND THE DOCUMENTS REFERRED AS BEING ATTACHED OR ENCLOSED HEREWITH ARE BEING FACSIMILE TRANSMITTED TO THE UNITED STATES PATENT AND TRADEMARK OFFICE ON <u>7/27/06</u> TO	
1.571.273.8300	By <u>Elizabeth A. Orr</u>

JUL 27 2006

Attorney Docket No. 0126-0008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT APPLICATION

Applicant : Hoeffler et al.
Application No. : 10/035,368 Confirmation No. : 2504
Filed : October 26, 2001
For : Microarrays and Uses Therefor
Group Art Unit : 1641
Examiner : Lisa V. Cook

July 27, 2006

Mail Stop Amendment

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REPLY TO ELECTION OF SPECIES REQUIREMENT

Sir:

Responsive to the Office Action mailed June 27, 2006, consideration of the following remarks is respectfully requested.

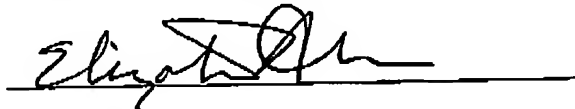
The Applicants traverse the requirement to elect a species, but to comply with the Action, hereby elect to prosecute Group II, drawn to a method of comparing protein expression in two or more populations of cells via "*a collection of antibodies (multiple and different) having recognized binding for different antigen(s)*". In traversing the requirement to elect species, Applicants submit that the antibodies recited in the claims, while patentably distinct, have a commonality of operation, function, and effect (MPEP 806.04(e)) with respect to the claimed methods, and should be examined together.

Applicants further disagree with the Office Action in the designations of claims into Groups I and II. The Office Action states that "claims 18, 21-24, 48-50, 61, 64, 68-70, 83, and 85-87 are drawn to a method of comparing protein expression in two or more populations of cells via *uncharacterized* antibodies with unknown specificity" [designated Group I by the Office Action], and that "claims 18, 71-82, and 84 are drawn to a method of comparing protein expression in two or more population of cells via *a collection of antibodies (multiple and different) having recognized binding for different antigen(s)*".

Applicants respectfully disagree that claims 18, 21-24, 48-50, 61, 64, 68-70, 83, 85, and 87 are drawn to methods using antibodies of unknown specificity. Applicants assert that only claim 86 does not belong in election Group II. All other claims are properly designated as Group II claims, including generic claims. Thus, applicants respectfully request that the Examiner reconsider the designation of claims 21-24, 48-50, 68-70 (drawn to origins and labels of cell lysates), 61, 64, and 85 (drawn to the type of solid support), 83 and 87 (drawn to steps of the method). None of claims 21-24, 48-50, 61, 64, 68-70, 83, 85, and 87 specify, incorporate, or require the use of "*uncharacterized* antibodies with unknown specificity". Thus Applicants respectfully request that the Examiner acknowledge that claims 18, 21-24, 48-50, 61, 64, 68-85, belong in election Group II.

Applicants respectfully assert that the pending application is now in condition for allowance. Prompt and favorable consideration of this Amendment and Reply is therefore respectfully requested.

Respectfully submitted,



Elizabeth A. Orr

Invitrogen Corp.

Reg. No. 45,937